



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0828-00
Application No.: 09/759,530

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Mireille MAUBRU et al.)
Application No.: 09/759,530) Group Art Unit: 1617
Filed: January 16, 2001) Examiner: S. Wang
For: DETERGENT COSMETIC COMPOSITIONS) Confirmation No.: 2122
COMPRISING A SPECIFIC AMPHOTERIC
STARCH, AND USES THEREOF)

Attention: Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 BOARD RULE § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellant presents this Reply to the Examiner's Answer dated January 16, 2007. A Request for Oral Hearing is concurrently filed with this Reply Brief.

If any fees are required in connection with the filing of this paper, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

REMARKS

I. Evidence Relyed Upon

Applicants agree with the Examiner's indication of the evidence relied upon in the rejection of the claims under appeal.

II. The Examiner's Has Not Established Obviousness

Despite the Examiner's myopic assertions to the contrary, he has not established that the prior art: a) teaches or suggests each and every element of the claims; or b) provides some teaching or suggestion that would have motivated one of ordinary skill in the art to combine the references in the manner proposed. Rather, for the reasons provided below, the Examiner's attempt to rebut Appellants' arguments only strengthen Appellants' point, as well as demonstrate the Examiner's incorrect standard for determining obviousness.

A. The Prior Art Does Not Teach All Claim Elements

The Examiner's assertion that Appellants argument is merely "based on the fact that one examples (*sic*) disclosed by Sweger employs fatty acid soaps," and that one of ordinary skill would not read the disclosure of Sweger and Babenko so narrowly, is not supported by the Examiner or the references. Examiner's Answer, pages 5-6.

For example, Sweger is not only **completely silent** with respect to cosmetic compositions containing, *inter alia*, a detergent in a cosmetic composition that is free from fatty acid soap, as claimed, but all of Sweger's examples contain triethanolamine

and stearic acid, which form fatty acid soap. See Sweger, examples and the Appeal Brief, page 14 (emphasis added).

Further, the Examiner argues that “there is no teaching or suggestion in Sweger... or Babenko... that the [disclosed] cosmetic care composition[s]... have to have fatty acid soaps as detergents[,]” and that “[d]isclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.” *Id.* at 6 (citation omitted).

As shown, contrary to the Examiner’s assertion, Sweger does not contain a “broader disclosure” or “non-preferred embodiments” that describe the use of detergents in compositions that do not contain fatty acid soap. See Appeal Brief, page 14. Accordingly, Sweger’s sole disclosure of the use of a detergent in a composition containing fatty acid soap clearly teaches away from the use of such detergents in compositions that do not contain fatty acid soap. For at least this reason, Appellants maintain that Sweger cannot be fairly interpreted as teaching or suggesting each and every element of the present claims, and certainly not without improper knowledge gleaned from the Appellants’ disclosure.

The other references cited by the Examiner in the §103(a) rejection do not cure Sweger’s deficiencies. As explained in the Appeal Brief, Babenko expressly incorporates the disclosure of Sweger. Appeal Brief, page 15. Thus, like Sweger, Babenko is fairly interpreted as disclosing detergent compositions that incorporate fatty acid soap. “A reference must be considered not only for what it expressly teaches, but for what it fairly suggests.” *In re Burckel*, 201 U.S.P.Q. 67, 70 (C.C.P.A. 1979). Unlike

both primary references, such compositions are expressly excluded from the claimed invention. See, e.g., claim 1 (“free of fatty acid soaps”).

While Murray and Saint-Leger may disclose other individual components of the claimed invention, they do not correct the deficiencies of Sweger and Babenko since they do not teach or suggest detergent and conditioning cosmetic compositions that are free from fatty acid soaps. Appeal Brief, pages 15-16.

For at least these reasons, the applied references do not teach or suggest each and every element of the claims. Therefore the rejection of claims 1-10, 12, 14, 16-18, 20-22 and 30-34 under 35 U.S.C. §103(a) is improper, and should be reversed.

B. There is No Motivation to Make the Proposed Modification

In his Answer, the Examiner asserts that “[o]ne of ordinary skill in the art would have been motivated to combine [the cited references] not merely because that each and every ingredients herein are known cosmetic ingredients, but to take advantage of the superior cosmetic properties of the amphoteric [starch] herein.” Examiner’s Answer at 6. Appellants respectfully disagree.

The Examiner’s arguments fail to consider the references as a whole, including the context in which the references disclose relevant components of the claimed composition. For example, the Examiner’s proffered motivation (“to take advantage of the superior cosmetic properties of the amphoteric starch”), is not only conclusory, but it does not supply the missing motivation. Indeed, if such a barren showing of motivation was sufficient, the Examiner could have easily applied the teaching of a Cosmetic Dictionary against the pending claims (and almost any other application directed to

cosmetic compositions) under the pretext that one would have been motivated to take advantage of the superior cosmetic properties of the disclosed ingredients.

What the Examiner is clearly (and wrongly) ignoring is the fact that while each of the asserted references may disclose individual aspects of the claimed invention, none of the references, alone or in combination, teach or suggest the *combination* of these elements, much less any beneficial results that may result from such a combination.

See *Environmental Designs, Ltd. v. Union Oil Co.* 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983) ("That all elements of an invention may have been old..., or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements.") Rather, some suggestion or motivation to combine references is necessary, e.g., from the prior art references themselves. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 37 U.S.P.Q.2d 1626, 1630 (Fed. Cir. 1996).

The Examiner's assertion of obviousness, however, does not properly rely on motivation, but rather on impermissible hindsight reconstruction of the claimed invention using the present specification as a guide. The Examiner's Answer, like every other Office Action to date, simply plucks individual elements of the present claims from the disclosures of Sweger, Babenko, Murray and Saint-Leger without a teaching, suggestion, or motivation to do so, to arrive at the claimed composition. See, e.g., Examiner's Answer at pages 6-7, Office Action dated December 21, 2005, page 4. Such practice is the very definition of impermissible picking and choosing. See Appeal Brief, page 20; *Wesslau*, 147 U.S.P.Q. 391, 393 ("[i]t is impermissible within the framework of section 103 to pick and chose from any one reference only so much of it

as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests.”).

The Examiner asserts, however, that Appellant’s improperly rely on *Wesslau* because “in *Wesslau*, the cited references lead away from the claimed invention... [however, in the present case] the cited references... do not particular require fatty acid soaps.” Appellants respectfully disagree.

Consideration of the disclosure of *Sweger* and *Babenko* as a whole clearly establishes that these references only contemplate the use of detergents in compositions containing fatty acid soap. Furthermore, as previously explained, none of the applied references teach or suggest the claimed combination of elements. Rather, each of these references disclose individual elements of the claimed invention in the context of cosmetic compositions that are, to a large extent, completely unrelated. The mere fact that *Sweger*, *Babenko*, *Murray* and *Saint Leger* broadly disclose cosmetic compositions does not provide motivation to combine individually recited components of these compositions in such a manner as to arrive at the claimed invention, when such combination is neither contemplated nor suggested by their respective disclosures.

The Examiner also asserts that Appellants reliance upon the *Gillette Co. v. S.C. Johnson & Son, Inc.* decision is improper, because unlike *Gillette*, “there are no unique, unexpected, or unobvious properties residing in the claimed invention.” Examiner’s Answer at page 8. Appellants respectfully disagree with the Examiner’s assertion for at least the following two reasons.

First, the Examiner’s argument against Appellants reliance upon *Gillette* directly contradicts his assertion that it would have been obvious to one of ordinary skill in the

art to combine Sweger, Babenko, Murray and Saint-Leger "to take advantage of the superior cosmetic properties of the amphoteric starch herein." Examiner's Answer at page 6. In other words, on the one hand the Examiner asserts that Appellants reliance on *Gillette* is improper, because there are allegedly no unique characteristics of the claimed composition. On the other hand, the Examiner asserts that one of ordinary skill in the art would have been motivated to combine the references in order to achieve the superior cosmetic properties of the claimed composition.

In reality, it is not the superior properties of the amphoteric starch *per se*, that leads to unobviousness, as alleged by the Examiner, but it is the unique properties of the composition to which the starch is added, that is clearly discussed in the original specification, and never taught in the prior art. Thus, to the extent that the Examiner's rationale over *Gillette* has any relevance to the claimed invention, it is clearly inconsistent with his own prior positions.

Second, Appellants note that the *Gillette* court's holding is premised on lack of knowledge of a claimed combination, and the "unique," not unexpected, results thereof. See *Gillette* at 1928. ("There is no question that each component of Monson's composition was separately known in the prior art. What was not known or suggested, however, was the composition that resulted from the combination of those components, and its unique properties"). Since the facts of the present case are similar to those in *Gillette*, namely that there was no teaching or suggestion in the prior art that known components could be combined, and that such a combination would lead to unique properties, the Board should follow the lead of the court in *Gillette*, and find the present

claims unobvious and patentable. For at least these reasons, Appellants respectfully submit that the Examiner's position with respect to *Gillette* is incorrect.

III. Conclusion

For the reasons of record and those set forth above, Appellants respectfully submit that the Examiner has failed to demonstrate at least two of the criteria needed to establish a *prima facie* case of obviousness. Specifically, the Examiner has failed to establish that the prior art teaches or suggests each and every element of the claims. Further, the Examiner has not established that one of ordinary skill in the art at the time the invention was made would have been motivated to combine the cited references in the manner asserted so as to arrive at the claimed invention. Appellants therefore request that the applied 35 U.S.C. §103(a) rejection of the present claims be reversed and withdrawn.

Please grant any extensions of time required to enter this brief and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

/Louis Troilo/

Dated: March 15, 2007

By: _____
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